UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,234	12/21/2004	Chua Chien Liang	2004-342	9708

27569   7590   11/19/2009
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EXAMINER
KIM, TAE K

ART UNIT	PAPER NUMBER
2453	

NOTIFICATION DATE	DELIVERY MODE
11/19/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action *Before the Filing of an Appeal Brief*	Application No. *10/519,234*	Applicant(s) LIANG, CHUA CHIEN	
	Examiner TAE K. KIM	Art Unit 2453	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>04 November 2009</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

  a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

  b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

    Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☒ The Notice of Appeal was filed on <u>05 November 2009</u>. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

  (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

  (b)☐ They raise the issue of new matter (see NOTE below);

  (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

  (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

  The status of the claim(s) is (or will be) as follows:

  Claim(s) allowed: _____.

  Claim(s) objected to: _____.

  Claim(s) rejected: *33, 35, & 37-42*.

  Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Joseph Thomas/
Supervisory Patent Examiner, Art Unit 2453

/Tae K. Kim/
Tae K. Kim,
Examiner, Art Unit 2453

Continuation of 11. does NOT place the application in condition for allowance because: Foremost, the amendments to Claims 40-42 will not be entered since the amendments do provide more weight to the phrase "there is only one last new member of the group at any given point in time." Using the term "so" still provides little or no weight to that particular limitation. MPEP 2173.02 states "if the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See Morton Int 'l, Inc. v. Cardinal Chem. Co., 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993).

Regarding Claims 33, 35, 37, 38, 40 and 41, the Examiner states that a prior art reference must be considered in its entirety. See MPEP 2141.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The Examiner incorrectly cited the same figures and passages for several claim limitations due to copy/paste function errors. However, the refence cited discloses the limitations as a whole and is further addressed below.

Regarding Claim 40, the claim limitation describing a method comprising "each participating person selecting a set of indications" and "the set of indications consisting only of at least one other participaing person that said each participating person wishes to meet" is anticipated by Wilens. The claim language does not limit the term "indication" as an actual person as the Applicant argues. The "indications," in its broadest reasonable interpretation, describe certain characteristics that are desireable for each participating person. Wilens discloses that a subscriber enters profile information [Fig. 6A] and match criteria [Fig. 6C, 6D] to indicate the types of people that the subscriber wishes to meet [Col. 5, line 29 - Col. 6, line 7]. Therefore, Wilens references that each subscriber defines certain criteria other subsribes must meet to become part of the same group.

The limitation of "processing the set of indications recorded in the database by a computerized system to form the group" is also anticipated by Wilens. The user can create a group by having the compute compare the user's personal profile and other subscribers' personal profiles and create a group using a computer algorithm to assign value to the preferences provided by the user and other subscribers [Fig 7A; Col. 8, line 54 - Col. 9, line 14]. Furthermore, the claim language does not specify that the set of indications are different form the profile information of the subscribes as the Applicant argues [See Remarks Pg. 7]. There is no distinction between the claimed limitation and Wilens.

The limitation of "including as a first member of the group any participating person who has indicated at least one other participating person in the set of indications, thereby becoming a last new member of the group" is anticipated by Wilens. As stated above, The user can create a group by having the compute compare the user's personal profile and other subscribers' personal profiles and create a group using a computer algorithm to assign value to the preferences provided by the user and other subscribers [Fig 7A; Col. 8, line 54 - Col. 9, line 14]. Wilens further discloses that the user becomes the first member of the group and subscribers that are to be included in the group must have calculated similarity values to the user that exceed a certain threshold [Col. 9, lines 15-34]. The claim language does not speicify that the subscribers must know each other before they are included in the group as the Applicant argues [See Remarks Pg. 7]. There is no distinction between the claimed limitation and Wilens.

The limitation of "including in the group another partiicpating person indicated in the set of indications of the last new member of the group, said another participating person thereby then becoming the last new member of the group after joining the group, the method working in such a way that there is only one last new member of the group at any point in time" is anticipated by Wilens. As stated above, a user can create a group and have the computer compare other subscribers' personal profiles to calculate similarity values to determine if other subscribers' are to be included in the group [Col. 8, line 57 - Col. 9, line 33]. Furthermore, it is clear that each subscriber's preferences are also considered to determine if that subscriber is to be included in the group [Col. 9, lines 19-27]. Therefore, there is no distinction between the claimed limitation and Wilens.

The limitation of "repeatedly including new persons to the group by the above step (ii) until a new person to be included in the group is already included in the group" is anticipated by Wilens. The muli-way match is not contrary to this claim limitation since the first condition that the subscriber meets the preference criteria of the user provides that a participating person (subscriber) in the set of indication (preference criteria) is included in the group. The second condition is that the user meets the preference criteria of the subscriber providing that new persons that are already in the group (user) that meet the subscriber's (last new member of the group) set of indication (preference criteria) are not included in the group. The including step does not specify that a third comparision must be made using a third subscriber and their respective set of indications. Therefore, there is no distinction between the claimed limitation and Wilens.

Regarding Claim 41, the Applicant asserts identical arguments as set forth regarding Claim 40. These arguments have already been adressed above.

Regarding Claim 37 and 38, Wilens discloses that the user can modify an existing group by changing the name and include new members based upon email addressed entered by the user [Fig. 9]. Furthermore, each subscriber's profile includes interests and preferences that are used by the computer to generate matches to create a group [Fig. 6C, 6D]. Therefore, the profiles in Wilens include references to any other peson that the subscriber ins interested in meeting contrary to Applicant's remarks on Pg. 11.

Regarding Claims 39 and 42, Applicant argues that since McGeachie teaches a method and system using multiple database, the teachings of McGeachie cannot be combined with Wilens [See Remarks Pg. 12]. Examiner disagrees with this assertion. Foremost, the number of processors or databases is not evidence of not common objective or purpose as asserted by the Applicant. Wilens discloses a group of subscribers accessing a service performed by another computer. It is inherent that the subscribers are accessing this service using a

different computing device since the subscribers utilize a website provided on the internet to utilize this service [Fig. 3; Col. 4, lines 34-44]. Furthermore, the Wilens invention is also not limited to a single database since a profile database and a group record database are disclosed [Fig. 2, item 140, 144].

The Applicant further asserts that the participating corporations are aware of each other before joining the group [See Remarks Pg. 13]. The claim language does not specifically state that each participant is unaware of each other prior to joining the group.